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# FEE TRANSMITTAL for FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 0

## Complete if Known

Application Number	09/664,794
Filing Date	September 19, 2000
First Named Inventor	FRANKLIN C BRADSHAW
Examiner Name	J. SELLS
Art Unit	1734
Attorney Docket No.	081069-0271077

## METHOD OF PAYMENT (check all that apply)

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## FEE CALCULATION

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fee Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150 <del>100</del>	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

### 2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims - 20 or HP = Extra Claims X Fee (\$) = Fee Paid (\$) Multiple Dependent Claims  
HP = highest number of total claims paid for, if greater than 20 Fee (\$) Fee Paid (\$)

Indep. Claims - 3 or HP = Extra Claims X Fee (\$) = Fee Paid (\$)  
HP = highest number of independent claims paid for, if greater than 3

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets - 100 = Extra Sheets /50= Number of each additional 50 or fraction thereof x Fee (\$) = Fee Paid (\$)  
250.00

### 4. OTHER FEE(S)

Non-English Specification, 130 fee (no small entity discount)

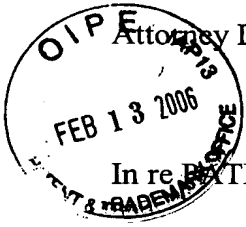
Other: \_\_\_\_\_

### SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	43560	Telephone	703.770.7538
Name (Print/Type)	Bryan E. Collins	Date	February 13, 2006		

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Attorney Docket: 081069-0271077

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re **PATENT APPLICATION** of

Confirmation No: 1859

**BRADSHAW et al.**

Group Art Unit: 1734

Application No: 09/664,794

Examiner: James D. Sells

Filed: September 19, 2000

**FOR: LAMINATING AND ADHESIVE TRANSFER APPARATUS**

\* \* \* \* \*

February 13, 2006

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit this Reply Brief in response to the Examiner's Answer dated December 13, 2005. The Examiner's December 13<sup>th</sup> Answer was a supplemental Answer, as it was issued in response a Remand issued by the Board of Patent Appeals & Interferences on June 23, 2005. Thus, this Reply Brief is being filed as a request that the appeal be maintained pursuant to 37 C.F.R. § 41.50(a)(2)(ii).

The Applicants request the Board to note that this application is a reissue application, and thus has "special" status. An early decision is respectfully requested.

**Procedural Background**

Because the procedural history of this appeal is rather unusual, the Applicants believe that a brief description is in order. In particular, because four separate Examiner's Answers have issued over the course of this appeal, and much of the Applicants' argument in this Reply Brief refers to those Answers, it is believed that a brief explanation of the procedural history will be helpful.

This reissue application is a continuation of U.S. Application No. 09/213,876, which is also a reissue application and has issued as U.S. Patent No. RE37,345. These reissue applications are based on U.S. Patent No. 5,584,962.

This reissue application was prosecuted in a rather typical fashion, with Office Actions being issued and Amendments/Responses being filed to amend the claims and/or argue rejections. Eventually, a Notice of Appeal was filed on January 17, 2003, and the Applicants filed an Appeal Brief on February 14, 2003. The Examiner issued an Answer on June 4, 2003.

The Applicants filed a Reply Brief on July 24, 2003. Normally, this would have been the end of briefing on appeal. However, in that Reply Brief, the Applicants addressed Ex Parte Eggert, 67 U.S.P.Q.2d 1716 (Bd.Pat.App. & Interf. May 29, 2003) which issued just days before the Examiner's June 4<sup>th</sup> Answer was mailed. In order to take this case into consideration, the Examiner vacated his first Answer and issued a new (second) Answer dated November 7, 2003. The Applicants did not file a further Reply Brief.

On July 22, 2004, the Board issued an Order Returning Undocketed Appeal To Examiner. This Order noted an ambiguity concerning the status of claims 47 and 48, and requested clarification. Again, the Examiner issued another (third) Answer, this one dated August 12, 2004.

After oral argument, the Board issued a Remand pursuant to 37 C.F.R. §41.50(a)(1), dated June 23, 2005. The Remand held that the Examiner's rejection failed to establish a prima facie rejection under the recapture rule. The specifics of the Remand are discussed below in the Argument section.

On December 13, 2005, the Examiner issued a fourth Examiner's Answer in response to the Remand. This Reply Brief is being filed in response to that fourth Answer.

To avoid confusion in this Reply Brief, the Applicants will refer to the Examiner's Answer of August 12, 2004 as the "Prior Examiner's Answer" or the "Prior Answer." The Examiner's Answers of June 7, 2003 and November 7, 2003 were vacated and superseded by the Answer of August 12, 2004. Thus, any reference to a Prior Answer refers to the August 12<sup>th</sup> Answer, as that was the one eventually considered by the Board. Further, the Applicants will refer to the Examiner's Answer of December 13, 2005, issued after the Board's Remand, as the "New Examiner's Answer" or "New Answer." Because four separate Examiner's Answers have been issued in this matter, it is believed that this nomenclature should distinguish between the various Answers discussed below in Applicants' arguments.

Argument

The only rejection at issue in this appeal is a recapture rejection under 35 U.S.C. §251. Specifically, the Examiner contends that reissue claims 36-48 are unpatentable because they attempt to improperly recapture subject matter surrendered during the prosecution of the original patent. For the reasons advanced below, in addition to the reasons advanced in the Applicants' prior Appeal and Reply Briefs,<sup>1</sup> the Applicants submit that the Examiner has still not established a *prima facie* recapture rejection.

I. The Examiner's Rejection Should be Reversed Because It Still Treats The Issued Claims As The Surrendered Subject Matter

The Examiner's rejection as set forth in the New Answer should be reversed for failing to establish a *prima facie* recapture rejection under 35 U.S.C. §251. The shortcomings of the Examiner's argument are straightforward, as the Examiner is incorrectly treating the "pretensioning means" limitations of patent claim 10 as the "surrendered subject matter." The Board's Remand held that the Examiner's rejection, as set forth in his Prior Answer, did not establish a *prima facie* recapture rejection for this very reason. The Examiner's position in his New Answer yet again suffers the exact same shortcoming.

Specifically, the Board's Remand stated, at page 12:

In the recapture rejection before us in this appeal, the examiner has not compared the subject matter of claims 36 to 48 to the "surrendered subject matter." Instead, the examiner has compared claims 36 to 48 to the allowed claims that issued as the patent.<sup>6</sup> As such, the Examiner has not set forth a *prima facie* case to support a recapture rejection. (underlining in original).

Further, the footnote numbered 6 at the end of the second sentence in that passage stated:

<sup>6</sup> In that regard, the text of the "pretensioning means" quoted by the examiner as being part of the surrendered subject matter (see page 2 of this decision) is incorrect since that language was added by the appellants to secure allowance. That is, claim 11 with the "pre-tensioning means" quoted by the

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<sup>1</sup> The Applicants' Appeal Brief and the Reply Brief of July 24, 2003 discuss the claims of the original patent and its underlying application, the present reissue claims 36-48, and the applicability of the recapture rule. Those Briefs include detailed analyses of caselaw, and detailed reasons why the recapture rule does not apply to reissue claims 36-48. Because this brief is a Reply Brief, there is no reason to re-state the arguments and analysis set forth in those Briefs. In the consideration of this Appeal, the Applicants respectfully request the Board to consider all arguments made in those briefs. The Applicants continue to maintain the arguments set forth in those Briefs, and intend to preserve those arguments in the event a further appeal is necessary.

examiner was never subject to any rejection and thus never became surrendered subject matter. (Underlining added).

The Board also pointed out that the Examiner must apply the three step process set forth by In re Clement, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (Fed. Cir. 1997). While the Examiner completed the first step (determining whether the reissue claims are broader than the patent claims, and in what aspects), the Board noted that the Examiner had failed to complete the second and third steps. Remand at 13. As stated in the Remand, the second step requires the Examiner to determine “whether the broader aspects relate to surrendered subject matter,” and the third step requires the Examiner to determine “whether the reissue claims have been materially narrowed in other respects to avoid the recapture rule.” Id. Accordingly, the application was remanded to the Examiner for further consideration.

The Examiner’s New Answer still fails to establish a *prima facie* recapture rejection because it again cites the “pretensioning means” of the issued patent claims as being the “surrendered subject matter.” Examiner’s New Answer at 3-4. The Examiner also states that “Newly added claim 36 does not include the limitations which applicant presented in Application No. 08/247,003 [the original patent] to overcome the prior art of record. Thus applicant is attempting to recapture subject matter that was surrendered in Application No. 08/247,003.” Id. By this, the Examiner is apparently referring to the mere omission of the “pretensioning means” limitations as being an improper attempt to recapture surrendered subject matter. Moreover, in an attempt to comply with the Board’s remand, the Examiner applies the three step analysis from In re Clement. Id. at 7-9. However, in conducting this analysis, the Examiner again uses the “pretensioning means” as the surrendered subject matter. At no point in the Examiner’s New Answer did he ever treat anything else as the surrendered subject matter, and the “pretensioning means” is treated as being the surrendered subject matter throughout the New Answer.

The Board’s Remand was clear that the Examiner’s Prior Answer did not establish a *prima facie* recapture rejection because he was treating the “pretensioning means” as the surrendered subject matter. Remand at 12 (“In that regard, the text of the ‘pretensioning means’ quoted by the examiner as being part of the surrendered subject matter (see page 2 of this decision) is incorrect[.]”). Despite this clear and unambiguous finding by the Board, the Examiner’s New Answer still treats the “pretensioning means” as the surrendered subject matter. Thus, the Board’s finding that the Examiner’s Prior Answer failed to establish a *prima facie* recapture rejection should apply equally here to the Examiner’s New Answer.

Therefore, the Applicants respectfully request the Board to find yet again that the Examiner has failed to establish a *prima facie* recapture rejection. For at least this reason, reversal of the rejection is requested.

II. The Examiner's Analysis of Whether Addition of the Materially Narrowing "Outer Shell" Limitations Avoids the Recapture Rule Is Incorrect

As mentioned above, in his New Answer, the Examiner attempted to apply the three step In re Clement test to the present reissue claims. Clearly, the Examiner failed to complete the second step of determining whether the broadening relates to the "surrendered subject matter" because he has incorrectly identified it as being the "pretensioning means." See Section II, supra. For the reasons discussed below, the Applicants also submit that the Examiner incorrectly applied the third step of the In re Clement test, relating to the presence of narrowing limitations in the reissue claims, to the pending reissue claims.

In the Examiner's third step of the analysis under In re Clement, as set forth in the New Answer, the Examiner states:

Regarding the third step, applicant has materially narrowed the reissue claims in other respects not related to the surrendered subject matter. Applicant has added new limitations to the claims by reciting that the "frame" includes:

an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower shell portion by manually engaging said upper shell portion directly and lifting said upper shell portion upwardly to said open position thereof.

These added limitations concerning the "outer shell" are not related to the surrendered subject matter concerning the "pretension means." As stated in the decision of In re Clement, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. Therefore the recapture rejection is believed to be appropriate in this instance.

The Applicants respectfully submit that this analysis is incorrect. As a threshold matter, the “pretensioning means” is not the surrendered subject matter. Thus, the Examiner’s analysis fails for at least the reason that the Examiner is not comparing the narrowing limitations to the correct “surrendered subject matter.” Further, the test in In re Clement does not inquire whether the narrowing limitations added to the reissue claims are “related” to the limitations omitted from the patent claims. Instead, the question involves the germaneness of the limitations to the prior art rejection(s). Specifically, In re Clement states:

From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rules bars the claim; (2) if it is narrower in all aspects, the recapture rules does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rules does not bar the claim, but other rejections are possible. 131 F.3d at 1470, 45 U.S.P.Q.2d. at 1165.<sup>2</sup>

It is apparent that the Examiner is asserting that the reissue claims fall into category 3(a).

The Applicants do not dispute that the “pretensioning means” limitations were added to patent claim 10 over the course of two amendments to overcome prior art rejections based in part on U.S. Patent No. 4,619,728 to Brink. However, the analysis does not stop there, and the germaneness of the limitations omitted from the canceled or amended claim and the narrowing limitations added to the reissue claim must be considered relative to the prior art. In Ex Parte Eggert, the Board considered a limitation to be germane if it defines the claim

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<sup>2</sup> The Applicants submit that this analysis in In re Clement is dicta and is not the holding of the case. Instead, the Applicants submit that this test was set forth in an effort to explain and clarify the holdings of various cases where narrowing limitations (relative to the surrendered subject matter) were present in the reissue claims. In particular, the Court was clarifying the disparate outcomes in Ball Corp. and Mentor. This articulation of categories 3(a) and 3(b) was not even dispositive in In re Clement because the reissue claim did not fall into either category. The Applicants submit that the proper test is simply to inquire whether the reissue claim is materially narrower than the surrendered subject matter. See Appeal Brief at 5-14. See also, Ball Corp., 729 F.2d 1429, 1438, 221 U.S.P.Q.2d 289, 296 (Fed. Cir. 1984) (“[T]here is widespread agreement that reissue claims that are narrower than the cancelled claims are allowable”). This is because the purpose of the re-capture rule is to prevent reissue applicant from obtaining a reissue claim that it surrendered during the original prosecution. A claim that is materially narrower than a surrendered claim cannot be “re”-captured because the applicant never possessed it in the first instance. However, for the purposes of this Reply Brief, the Applicants maintain that even if the materially narrowing analysis in In re Clement is correct, the Examiner still has applied it incorrectly to the present reissue claims.

over the prior art. Ex Parte Eggert, 67 U.S.P.Q.2d at 1731. Here, the narrowing limitations of the “outer shell” are germane to the prior art, and specifically to the rejection based on Briak, because they patentably distinguish the reissue claims from Brink. Indeed, the Examiner applied Brink in a rejection in this reissue application, and the Applicants amended the claims to further distinguish them from Brink. See Office Action dated March 2, 2001 and Amendment dated May 16, 2001. There is no dispute that the relevant “outer shell” limitations distinguish the reissue claims over the prior art. Thus, the Applicants submit that these “outer shell” limitations are germane to a prior art rejection in the context of In re Clements’ three step test. This is because the prior art rejections faced in both the original prosecution and in this reissue prosecution were based on the same primary reference of Brink, and there is no dispute that the “outer shell” limitations distinguish the reissue claims from that reference. See Ex Parte Eggert, 67 U.S.P.Q.2d at 1731 (“Since these limitations of claims 15 and 22 define the claimed subject over the applied prior art these limitations are germane to a prior art rejection.”).

Accordingly, because the reissue claims are materially narrower in aspects germane to a prior art rejection, they cannot fall into category 3(a) and be rejected solely on that basis. Indeed, the Applicants submit that the reissue claims better fit category 3(b), to which the recapture rule does not apply. Specifically, the limitations in the surrendered version of patent claim 10<sup>3</sup>, i.e., “the surrendered claim,” that are now omitted from the reissue claims were not material or germane to patentability because they were not sufficient to distinguish the claim from the prior art. Indeed, it was not until the Applicants added the specific structures of the “pretensioning means” to patent claim 10 (then application claim 11) that the Examiner considered the claim to be patentable. Therefore, the Applicants submit that the limitations presented in that “surrendered claim,” but now omitted from the reissue claims, cannot be considered germane to the prior art rejection because they did not define the claim over the prior art.

Accordingly, the Applicants submit that, in applying the third step of the In re Clement test, the Examiner should have found the reissue claims as falling into Category 3(b) and determined that the recapture rule does not apply.

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<sup>3</sup> Applicants are referring to application claim 11 as it existed after the first Amendment of July 5, 1995, but before the second Amendment of October 25, 1995 that placed the claims in a condition for allowance. See Remand at 4-7. Such omitted limitations would include, among other things, the “actuating means” and more generic recitation of the “pre-tensioning means.” However, the specific structures of the “pre-tensioning means,” such as the “tensioning cap,” “end plate,” and “biasing means” would clearly not be considered omitted limitations relative to the surrendered subject matter, as they were never in any claim that was canceled or further amended.



In essence, the Applicants seek to correct the error of adding certain overly narrow limitations, and obtain a patentable claim with different materially narrowing limitations concerning the construction of the “outer shell.” The Applicants submit that narrowing the reissue claims with the newly added “outer shell” limitations provides a claim that was never presented during the original prosecution, and thus was never conceded as unpatentable by way of a canceling or amending a claim. As such, the Applicants respectfully submit that this cannot be regarded as impermissible recapture because they never possessed the present reissue claims during the original prosecution. See Application of Willingham, 282 F.2d 353, 357, 122 U.S.P.Q.2d 211, 215-16 (CCPA 1960) (“The appealed [reissue] claims differ materially from cancelled claim 12 and there is nothing of record on which to base a holding that the reissue claims on appeal were not, in fact, patentable to the appellant at the time claim 12 was deleted”).

Ex Parte Eggert is illustrative in this respect. In Ex Parte Eggert, the Board provided specific examples illustrating what would be considered to be improper recapture and permissible claim broadening. Specifically, the Board stated:

For example, if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC<sup>BR</sup>, etc.).<sup>4</sup> However, it is our view that the reissue recapture rule is not invoked for claims directed to elements ABCX, ABCD<sup>BR</sup>, ABCEF, A<sup>BR</sup>BCDEF. In other words, the focus for determining the reach of the reissue recapture rule should be the claim from which the issued claimed directly evolved, not the issued claim itself. 67 U.S.P.Q.2d at 1718.

These examples clearly support the proposition that the proper analysis is to compare the reissue claim to the “surrendered” claim to determine whether the reissue claim is of essentially the same scope as the “surrendered” claim; and also that the analysis is not simply to compare the reissue claim to the issued claim and determine whether the limitations included in the issued claim to secure allowance were broadened in the reissue claim. For example, the Board identified three examples of valid reissue claims where one or more of the DEF limitations (i.e., the limitations included to secure allowance) were omitted from the reissue claim. Further, the Board even identified an example of a valid reissue claim where

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<sup>4</sup> The BR superscript indicates that element C in the reissue claim is broader than element C in the rejected claim (i.e., the outer circle claim).

the original limitation A was broadened. The commonality between all these examples of valid reissue claims is that they each include a narrowing limitation besides the original ABC limitations of the “surrendered” claim; and the commonality between all the examples of invalid reissue claims is that they are each of equal or broader scope in all respects than “surrendered” claim ABC and do not include any additional materially narrowing limitations. Indeed, the Board identified an example (ABCX) where all the limitations added by way of amendment were omitted, and a different limitation was added. Notably, this is exactly the case here with the present reissue claims.

Here, the Applicants reissue claims are materially narrower by virtue of the limitations concerning the “outer shell” than any “surrendered” claim originally presented and rejected during prosecution, and thus would best fit the examples of valid reissue claims enumerated by the Board in Ex Parte Eggert. That is, the pending reissue claims share the common feature with those valid reissue claim examples of having an additional materially narrowing limitation besides those originally presented in the “surrendered” claim.

Further, the Board in Ex Parte Eggert recognized that by making an overly narrowing amendment, a patent applicant may have “overshot the mark.” Id. at 1717. Here, the facts show that the Applicants indeed did overshoot the mark by adding the narrowing limitations concerning the “pre-tensioning means” to secure allowance of claim 10. In reviewing the prosecution history of the ‘962 patent, it was realized that, because the Examiner had originally interpreted the limitations concerning the movable parts of the frame as being broad enough to cover movable internal parts of the frame, the Applicants should have originally amended the claim to more narrowly define those movable parts as being part of the outer shell to distinguish from the prior art. However, that was not done, and instead the Applicants “overshot the mark” by adding the overly narrowing “pre-tensioning means” limitations. On reissue, this is the error the Applicants seek to correct by the pending reissue claims, and Applicants request that they be allowed to do so.

### III. Conclusion

The fundamental shortcoming of the analysis underlying the Examiner’s position is that he has focused entirely on the “pretensioning means” as the surrendered subject matter. In contrast, the law is clear that the surrendered subject matter is the claim scope the Applicants conceded to be unpatentable, either by canceling or amending a claim. See Ball Corp., 729 F.2d at 1436, 221 U.S.P.Q.2d at 295 (“The recapture rule bars the patentee from

acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application.”). Indeed, “the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the cancelled claims.” *Id.* (italics in original). Applying this approach to the present application, the Examiner must determine whether the Applicants are attempting to recapture the scope of patent claim 10 as it existed prior to being amended during the original prosecution. Despite the Board’s clear statements in its Remand, the Examiner again has failed to engage in this analysis. Regardless, as discussed extensively in the Appeal Brief, the Applicants are not impermissibly recapturing surrendered claim scope because the reissue claims include the additional limitations concerning the “outer shell,” which were not included in any original or issued claims, and which the Examiner acknowledges renders the reissue claims as being materially narrowing limitations. See, e.g., Examiner’s New Answer at 5 (“The Examiner has considered the materially narrowing changes relating to the ‘outer shell portion’.”).

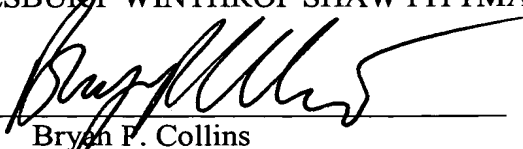
In conclusion, the Applicants respectfully submit that, based on the reasons advanced above, in addition to the reasons set forth in the Appeal Brief previously filed, the claims 36-48 are not barred by the recapture rule, and thus are patentable under 35 U.S.C. § 251. Accordingly, reversal of the Examiner’s rejection under 35 U.S.C. § 251 with respect to claims 36-48 is requested.

Because this application has been remanded by the Board once already on this recapture issue, the Applicants respectfully request that the Board reverse the Examiner’s rejection without a remand. The Applicants note that their Notice of Appeal was filed over three years ago, and that the prolonged pendency of a reissue application cannot be made up for by a patent term extension. Thus, the Applicants submit that a dispositive decision by the Board would be appropriate.

Respectfully submitted,

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